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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,632	05/23/2001	Michael Benz	12758-027001	3136
26161	7590	11/19/2004	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			TON, ANTHONY T	
			ART UNIT	PAPER NUMBER
			2661	

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/856,632

Applicant(s)

BENZ ET AL.

Examiner

Anthony T Ton

Art Unit

2661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/29/2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 12, 28 and 29 is/are rejected.
- 7) ☒ Claim(s) 13-27 and 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/23/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

PHIRIN SAM
PRIMARY EXAMINER

DETAILED ACTION

Drawings

1. **Figure 4** should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. According to Figure 1 in page 8 of the Prior Art document ETSI SMG2/UMTS L23 Expert Group, on October 6, 1998, the drawing of the Applicant's Fig.4 is the same as that of the Prior Art's Fig.1.

See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. **Claims 12-27** are objected to because of the following informalities:

In Claim 12: Term "**claim 1**" in line 1 is improper since the claim 1 was deleted by the Applicant's Preliminary Amendment filed on January 29, 2002. This would be a typographical error.

Examiner suggests changing this term to "**claim 11**".

Appropriate correction is required.

Claim Rejections - 35 USC § 103

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 11, 12, 28 and 29** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Widegren et al.* (US Patent No. 6,374,112) hereinafter referred to as *Widegren*, in view of *ETSI SMG2/UMTS L23 Tdoc 357/98 Expert Group, Layer 1 Generation Requirements, October 6, 1998*. (IDS supplied by the Applicant on May 23, 2001) hereinafter referred to as *Expert Group*.

a) **In Regarding to Claim 11:** *Widegren* disclosed a method for transmitting data for a data communication service, the method comprising:

stipulating a number of permitted transport formats and a combination of the permitted transport formats for the data communication service (*see abstract and see col.3 lines 22-42: UTRAN includes an ATM connection, and CDMA spreading codes*);

using a binary code that includes a reduced number of the permitted transport formats relative to a total number of the combination of the permitted transport formats (*see col.6 line 51-col.7 line 9: The RAN interface therefore permits the use of relatively simple, high level signaling commands to establish, maintain, and release radio access bearers through UTRAN (hence, a reduced number of the permitted transport formats), assigning multiple bearer connections to a specified CDMA spreading code (hence, a binary code)*); and

transmitting the data via a jointly used physical channel based on the combination of the permitted transport formats (*see abstract and col.3 lines 32-42: physical transport resources*).

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Widegren signaling a partial information item to the combination of the permitted transport formats.

Expert Group explicitly disclosed such signaling a partial information item to the combination of the permitted transport formats (*see Pages 11 and 12: Uplink and Downlink models: The current configuration of the coding and multiplexing unit is either signaled to, or optionally blindly detected by the network for each 10-ms frame ... TFCI is mapped onto the physical channel carrying the power control bits and the pilot*).

At the time of the invention, it would be obvious to a person of ordinary skill in the art to combine such signaling a partial information item to the combination of the permitted transport formats, as taught by *Expert Group* with *Widegren*, so that a plurality of data link channel can be processed and multiplexed together by a same coding and multiplexing unit. The motivation for doing so would have been to provide physical channels carrying the same physical data stream can be combined in a UE receiver (*see Expert Group: Page 13 lines 10-12*). Therefore, it would have been obvious to combine *Expert Group* with *Widegren* in the invention as specified in the claim.

b) In Regarding to Claim 12: *Widegren* further disclosed the method further comprising a data rate for combination of the permitted transport formats at the reception end (*see col.2 line 49 – col.3 line 6: a single data stream*).

c) In Regarding to Claims 28 and 29: The claimed subject matters of these claims are the same as that of claims 11 and 12, respectively. Therefore, the rejections to claims 11 and 12 would apply to reject these two claims, in a communication system as taught.

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Allowable Subject Matter

5. **Claims 13-27 and 30** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Examiner Information

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Anthony T Ton** whose telephone number is **571-272-3076**. The examiner can normally be reached on M-F: 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ken Vanderpuye** can be reached on **571-272-3078**. The fax phone number for the organization where this application or proceeding is assigned is **703-872-9306**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully submitted,

by: 
Anthony T. Ton
Patent Examiner
November 14, 2004


PHIRIN SAM
PRIMARY EXAMINER